



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,041	12/21/2001	Mary M. DaRif	6962	8619

7590 03/09/2004

The Sherwin-Williams Company  
Legal Dept.  
11 Midland Bldg.  
101 Prospect Avenue, N.W.  
Cleveland, OH 44115

EXAMINER

GREEN, BRIAN

ART UNIT	PAPER NUMBER
----------	--------------

3611

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/026,041

Applicant(s)

DARIF ET AL.

Examiner

Brian K. Green

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 1-9 are objected to because of the following informalities: In claim 1, line 2, "is-coated" should apparently be "is coated". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohse (U.S. Patent No. 750,620) in view of Teter et al. (U.S. Patent No. 6,112,665) and Lerner et al. (U.S. Patent No. 6,416,612).

Dohse shows in figure 3 a paint color card comprising a layer of a first colored composition (white and black are shown in figure 3) formulated to have a dried color that is substantially similar to dried color of a commercially-available paint composition. Dohse does not disclose coating the entire surface area of the color card with the first colored composition and placing perforations on the card so that a portion of the card can be detached. Teter et al. shows in figures 4 and 5 the idea of placing perforations (14) within a colored section in order to allow the perforated area to be removed. In view of the teachings of Teter et al. it would have been obvious to one in the art to modify Dohse by adding an additional set of perforations to each of the colored coated compositions since this would allow an opening to be formed within the

Art Unit: 3611

colored coated compositions which would allow better color matching to be performed, as taught by Teter et al., column 4, lines 55-65. Lerner et al. shows in figures 1-2 the use of a paint chip (14) that includes a composition (22) covering the entire area of the surface of the chip and includes indicia (30) for identifying the color of the composition. In view of the teachings of Lerner it would have been obvious to one in the art to modify Dohse by covering the entire surface area of the card since this would create a more aesthetically pleasing card, would allow the color on the card to be compared to other surfaces in a better manner, i.e. the color on the card would extend to the edges of the card which would allow for better comparison, and would allow a larger colored area to be shown on a desired surface. In regard to claim 2, when the perforated section is removed from the card a window would be created. In regard to claims 3 and 13, Dohse discloses the applicant's basic inventive concept except for making the chip sections square. Dohse discloses the idea of making the chip sections rectangular. It would have been an obvious matter of design choice to make the chip sections square since the applicant fails to provide any advantage to making the sections square and the rectangular sections taught by Dohse would work equally well. In regard to claim 11, the perforated section, could be separated along three sides and folded along the fourth side as defined.

Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohse (U.S. Patent No. 750,620) in view of Teter et al. (U.S. Patent No. 6,112,665) and Lerner et al. as applied to claims 1 and 10 above and further in view of Spangler (U.S. Patent No. 6,270,123) or the applicant's admitted prior art on pages 1 and 2 of the specification.

Art Unit: 3611

Dohse in view of Teter et al. and Lerner disclose the applicant's basic inventive concept except for making the color card out of paper. Dohse does not disclose what type of material is used to make the color card. Spangler discloses in column 6, lines 20-25 the idea of making a color card out of paper. The applicant discloses on page 1 that it is known to make color cards out of paper. In view of the teachings of Spangler or the applicant's admitted prior art it would have been obvious to one in the art to modify Dohse by making the color card out of paper since this would allow the card to be made in an easier and less expensive manner.

Claims 5-7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohse (U.S. Patent No. 750,620) in view of Teter et al. (U.S. Patent No. 6,112,665) and Lerner et al. as applied to claims 1 and 10 above and further in view of Day et al. (U.S. Patent No. 4,104,809)

In regard to claim 5,6, and 15, Dohse discloses the idea of placing indicia on each chip section to indicate the color of the paint chip but does not disclose placing a formula for the paint color. Day et al. shows in figure 1 the idea of placing indicia for indicating the color of each chip section and indicia for indicating a code/formula for each chip section. In view of the teachings of Day et al. it would have been obvious to one in the art to place the paint formula/code on each of the paint chip sections since this would allow a person to make the desired colored paint in an easier and faster manner. In regard to claim 7, Dohse discloses on page 1, column 2, lines 15-25, the idea of placing a code on the back of each chip section. It would have been obvious to one in the art to modify Dohse by placing the paint formula on the back of each chip section since this would allow the entire color on each of the paint sections to be seen and not be partially obscured by the indicia written thereon.

Claims 8,9,25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohse (U.S. Patent No. 750,620) in view of Teter et al. (U.S. Patent No. 6,112,665) and Lerner et al. as applied to claim 1 above and further in view of Edwards (U.S. Patent No. 4,992,050) or Goldsholl (U.S. Patent No. 3,224,113).

Dohse in view of Teter et al. and Lerner et al. disclose the applicant's basic inventive concept except for placing a color coating on the back of each chip section. Edwards discloses in the abstract the idea of placing a first color of paint on a first side of a chip section and a coating of paint on the opposite side of each chip section. Edwards discloses that the paint on the second side has a different finish as compared to the first side. Goldsholl discloses in column 1, lines 59-62, the idea of placing paint the front and back surfaces of a paint card. In view of the teachings of Edwards or Goldsholl it would have been obvious to one in the art to modify Dohse by placing a coat of paint on the second surface of each chip section since this would allow more colors/finishes to be displayed by the color card or would allow the paint color to be shown on both sides of the card. Edwards and Goldsholl disclose the idea of placing a paint composition on opposite sides of the paint card. It is considered within one skilled in the art to vary the color displayed on the sides of the card, i.e. the same color on opposite sides to achieve the advantage of allowing either side of the card to be viewed to determine the color of the cards or to display different colors on each of the sides in order to allow more colors to be shown by a single paint card. In regard to claims 8 and 25, it is considered within one skilled in art to place the same color on the back of each chip section as on the front since this would allow the color of the paint

Art Unit: 3611

to be seen on either side of the chip section, i.e. easier and quicker to determine the paint color shown by the color card.

Claims 1-3 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohse (U.S. Patent No. 750,620) in view of Teter et al. (U.S. Patent No. 6,112,665).

Dohse shows in figure 3 a paint color card comprising a layer of a first colored composition (white and black are shown in figure 3) formulated to have a dried color that is substantially similar to dried color of a commercially-available paint composition. The surface area of the first surface (as broadly defined, the surface area does have to be the entire area of the first surface) in Dohse is considered to be the area covered by the paint composition, figure 3, the areas covered by the black or white paint. Dohse does not disclose placing perforations on the card so that a portion of the card can detached. Teter et al. shows in figures 4 and 5 the idea of placing perforations (14) within a colored section in order to allow the perforated area to be removed. In view of the teachings of Teter et al. it would have been obvious to one in the art to modify Dohse by adding an additional set of perforations to each of the colored coated compositions since this would allow an opening to be formed within the colored coated compositions which would allow better color matching to be performed, as taught by Teter et al., column 4, lines 55-65. In regard to claim 2, when the perforated section is removed from the card a window would be created. In regard to claims 3 and 13, Dohse discloses the applicant's basic inventive concept except for making the chip sections square. Dohse discloses the idea of making the chip sections rectangular. It would have been an obvious matter of design choice to make the chip sections square since the applicant fails to provide any advantage to making the

Art Unit: 3611

sections square and the rectangular sections taught by Dohse would work equally well. In regard to claim 11, the perforated section, could be separated along three sides and folded along the fourth side as defined.

Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohse (U.S. Patent No. 750,620) in view of Teter et al. (U.S. Patent No. 6,112,665) as applied to claims 1 and 10 above and further in view of Spangler (U.S. Patent No. 6,270,123) or the applicant's admitted prior art on pages 1 and 2 of the specification.

Dohse in view of Teter et al. disclose the applicant's basic inventive concept except for making the color card out of paper. Dohse does not disclose what type of material is used to make the color card. Spangler discloses in column 6, lines 20-25 the idea of making a color card out of paper. The applicant discloses on page 1 that it is known to make color cards out of paper. In view of the teachings of Spangler or the applicant's admitted prior art it would have been obvious to one in the art to modify Dohse by making the color card out of paper since this would allow the card to be made in an easier and less expensive manner.

Claims 5-7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohse (U.S. Patent No. 750,620) in view of Teter et al. (U.S. Patent No. 6,112,665) as applied to claims 1 and 10 above and further in view of Day et al. (U.S. Patent No. 4,104,809)

In regard to claim 5,6, and 15, Dohse discloses the idea of placing indicia on each chip section to indicate the color of the paint chip but does not disclose placing a formula for the paint color. Day et al. shows in figure 1 the idea of placing indicia for indicating the color of each



Art Unit: 3611

chip section and indicia for indicating a code/formula for each chip section. In view of the teachings of Day et al. it would have been obvious to one in the art to place the paint formula/code on each of the paint chip sections since this would allow a person to make the desired colored paint in an easier and faster manner. In regard to claim 7, Dohse discloses on page 1, column 2, lines 15-25, the idea of placing a code on the back of each chip section. It would have been obvious to one in the art to modify Dohse by placing the paint formula on the back of each chip section since this would allow the entire color on each of the paint sections to be seen and not be partially obscured by the indicia written thereon.

Claims 8,9,25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohse (U.S. Patent No. 750,620) in view of Teter et al. (U.S. Patent No. 6,112,665) as applied to claim 1 above and further in view of Edwards (U.S. Patent No. 4,992,050) or Goldsholl (U.S. Patent No. 3,224,113).

Dohse in view of Teter et al. disclose the applicant's basic inventive concept except for placing a color coating on the back of each chip section. Edwards discloses in the abstract the idea of placing a first color of paint on a first side of a chip section and a coating of paint on the opposite side of each chip section. Edwards discloses that the paint on the second side has a different finish as compared to the first side. Goldsholl discloses in column 1, lines 59-62, the idea of placing paint the front and back surfaces of a paint card. In view of the teachings of Edwards or Goldsholl it would have been obvious to one in the art to modify Dohse by placing a coat of paint on the second surface of each chip section since this would allow more colors/finishes to be displayed by the color card or would allow the paint color to be shown on

Art Unit: 3611

both sides of the card. Edwards and Goldsholl disclose the idea of placing a paint composition on opposite sides of the paint card. It is considered within one skilled in the art to vary the color displayed on the sides of the card, i.e. the same color on opposite sides to achieve the advantage of allowing either side of the card to be viewed to determine the color of the cards or to display different colors on each of the sides in order to allow more colors to be shown by a single paint card. In regard to claims 8 and 25, it is considered within one skilled in art to place the same color on the back of each chip section as on the front since this would allow the color of the paint to be seen on either side of the chip section, i.e. easier and quicker to determine the paint color shown by the color card.

Claims 1-4 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lerner et al. (U.S. Patent No. 6,416,612) in view of Teter et al. (U.S. Patent No. 6,112,665).

Lerner et al. shows in figures 1 and 2 a paint color card (14) comprising a layer of a first colored composition (22) formulated to have a dried color that is substantially similar to dried color of a commercially-available paint composition. Lerner et al. does not disclose placing perforations on the card so that a portion of the card can detached. Teter et al. shows in figures 4 and 5 the idea of placing perforations (14) within a colored section in order to allow the perforated area to be removed. In view of the teachings of Teter et al. it would have been obvious to one in the art to modify Lerner et al. by adding an additional set of perforations to each of the colored coated compositions since this would allow an opening to be formed within the colored coated composition which would allow better color matching to be performed, as taught by Teter et al., column 4, lines 55-65. In regard to claim 2, when the perforated section is

Art Unit: 3611

removed from the card a window would be created. In regard to claims 3 and 13, Lerner et al. discloses the applicant's basic inventive concept except for making the chip sections square. Lerner et al. discloses the idea of making the chip sections rectangular. It would have been an obvious matter of design choice to make the chip sections square since the applicant fails to provide any advantage to making the sections square and the rectangular sections taught by Lerner et al. would work equally well. In regard to claim 11, the perforated section, could be separated along three sides and folded along the fourth side as defined. In regard to claims 4 and 14, Lerner et al. discloses in column 2, lines 60-61 the idea of making the card from paper.

Claims 5,6, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lerner et al. (U.S. Patent No. 6,416,612) in view of Teter et al. (U.S. Patent No. 6,112,665) as applied to claims 1 and 10 above and further in view of Day et al. (U.S. Patent No. 4,104,809)

In regard to claim 5,6, and 15, Lerner et al. discloses the idea of placing indicia on each chip section to indicate the color of the paint chip but does not disclose placing a formula for the paint color, see figure 1. Day et al. shows in figure 1 the idea of placing indicia for indicating the color of each chip section and indicia for indicating a code/formula for each chip section. In view of the teachings of Day et al. it would have been obvious to one in the art to modify Lerner et al. by placing the paint formula/code on each of the paint chip sections since this would allow a person to make the desired colored paint in an easier and faster manner.

***Response to Arguments***

Applicant's arguments filed Jan. 23, 2004 have been fully considered but some of the arguments are not persuasive.

The applicant argues that Dohse fails to anticipate amended claims 1 and 10 since these claims now require the entire first surface to be coated with the first coating composition. The examiner disagrees since the applicant actually defines in claims 1 and 10 that an area of the first surface is entirely coated with the first coating composition. The entire first surface does not have to be coated as broadly defined. Further, an additional reference has been added (Lerner et al.) to show that it is known to coat an entire first surface.

The applicant argues that the Edwards patent does not teach the idea of making the second coating composition the same as the first coating composition as defined in claim 8. Edwards and Goldsholl disclose the idea of placing a paint composition on opposite sides of the paint card. It is considered within one skilled in the art to vary the color displayed on the sides of the card, i.e. the same color on opposite sides to achieve the advantage of allowing either side of the card to be viewed to determine the color of the cards or to display different colors on each of the sides in order to allow more colors to be shown by a single paint card.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
BRIAN K. GREEN  
PRIMARY EXAMINER

Bkg  
March 5, 2004